

## REMARKS

### Summary of Office Action

As an initial matter, Applicants note with appreciation that at page 3 of the instant Office Action the Examiner states that the rejection of claims 6 and 30 under 35 U.S.C. § 103(a) over Fowler et al., U.S. Patent No. 5,720,961 (hereafter “FOWLER”) in view of Gordon et al., U.S. Patent No. 5,977,039 (hereafter “GORDON”) and Mercier et al., U.S. Patent No. 7,488,471 (hereafter “MERCIER”) is withdrawn. However, immediately after the corresponding statement claim 6 is listed as one of the claims that are rejected under 35 U.S.C. § 103(a) over FOWLER in view of GORDON and MERCIER. Moreover, this listing also includes claims 17 and 33, i.e., claims which have never before been rejected under 35 U.S.C. § 103(a) over FOWLER in view of GORDON and MERCIER alone. Clarification in this regard is respectfully requested.

Applicants further note that both in the Office Action Summary and at page 2 of the instant Office Action under the heading “Status of Claims” the Examiner incorrectly states that claims 1-37 and 40-47 are pending and under examination. Applicants point out that also claim 48 is pending in this application.

Claims 1-16, 18-29, 31, 32, 34-37 and 40-48 remain rejected and claims 17 and 33 are newly rejected (?) under 35 U.S.C. § 103(a) as allegedly being unpatentable over FOWLER in view of GORDON and MERCIER. In this regard, the Examiner’s attention is respectfully directed to the fact that rejected claims 38 and 39 are cancelled.

Claims 17 and 33 remain rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over FOWLER in view of GORDON, MERCIER and McLaughlin, US 2003/0133900 (hereafter “McLAUGHLIN”).

Claims 6 and 30 are newly rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over FOWLER in view of GORDON and Ha, U.S. Patent No. 5,585,104 (hereafter "HA").

**Response to Office Action**

Reconsideration and withdrawal of the rejections of record are again respectfully requested, in view of the following remarks.

***Response to the Rejection over FOWLER, GORDON and MERCIER***

Claims 1-16, 18-29, 31, 32, 34-37 and 40-48 remain rejected and claims 17 and 33 are newly rejected (?) under 35 U.S.C. § 103(a) as allegedly being unpatentable over FOWLER in view of GORDON and MERCIER. In this regard, the Examiner appears to rely on the allegations set forth in the previous Office Action by the previous Examiner. Applicants assume that this is the reason why MERCIER is not even mentioned in the body of the rejection.

Applicants respectfully traverse this rejection for all of the reasons that are set forth in the response to the previous Office Action. The corresponding remarks are expressly incorporated herein.

Further, reproduced below is claim 1 of FOWLER, i.e., the document which is primarily relied upon in the instant rejection:

A nonabrasive personal cleansing composition comprising:

(a) from about 0.05% to about 40% of water insoluble particles selected from the group consisting of polybutylene, polyethylene, polyisobutylene, polymethylstyrene, polypropylene, polystyrene, polyurethane, nylon, teflon, polyhalogenated olefins,

polyethylene/polypropylene copolymer, polyethylene/propylene/isobutylene copolymer, polyethylene/styrene copolymer and mixtures thereof having a mean particle size diameter from about 20 microns to about 50 microns, with greater than about 95% of said particles in said composition having a diameter less than about 75 microns,

(b) from about 0.05% to about 40% of a surfactant selected from the group consisting of sodium cetearyl sulfate, sodium lauryl sulfate, sodium lauryl sarcosinate, sodium cocoyl isethionate, coamidopropyl betaine, sodium laureth sulfate, cetyl dimethyl betaine, ammonium lauryl sulfate, sodium tallow soap, sodium coconut soap, ceteth-10, steareth-21, steareth-2, ceteth-2, glyceryl stearate, glucose amides, dilauryl dimethyl ammonium chloride, distearyl dimethyl ammonium chloride, dimyristyl dimethyl ammonium chloride, dipalmityl dimethyl ammonium chloride, and mixtures thereof,

(c) from 0% to about 50% of an emollient selected from the group consisting of mineral oil, petrolatum, cholesterol, dimethicone, dimethiconol, diisopropyl adipate, isopropyl myristate, myristyl myristate, cetyl ricinoleate, sorbitan distearate, sorbitan dilaurate, sorbitan stearate, sorbitan laurate, sucrose laurate, sucrose dilaurate, sodium isostearyl lactylate, lauryl pidolate, sorbitan stearate, stearyl alcohol, cetyl alcohol, behenyl alcohol, PPG-14 butyl ether, PPG-15 stearyl ether, and mixtures thereof;

(d) from about 20% to about 99.85% water,

(e) from about 0.1% to about 10% of a material selected from the group consisting of salicylic acid, lactic acid, glycolic acid, aloe vera, panthenol, pantothenic acid, clove oil, menthol, camphor, eucalyptus oil, eugenol, menthyl lactate, retinol, retinoic acid, azelaic acid, witch hazel distillate, allantoin, bisabolol, and mixtures thereof.

Instant claim 1, on the other hand recites:

A cosmetic or dermatological cleansing emulsion comprising:

(a) from 2 % to about 17 % by weight of at least one of sodium laureth sulfate and sodium myreth sulfate;

(b) from about 0.20 % to about 0.74 % by weight of one or more polyacrylates selected from anionic homopolymers and anionic copolymers of at least one of acrylic acid, an alkylated acrylic acid and esters thereof;

(c) from 42 % to about 51 % by weight of an oil phase comprising

(i) from about 25 % to about 50 % by weight of a paraffin oil,

(ii) from about 0.5 % to about 25 % by weight of one or more oils having a polarity of from about 5 to about 50 mN/m;

the emulsion having a viscosity of from about 500 to about 3,500 mPa s at 100 s<sup>-1</sup>.

A comparison of the above claims readily reveals that the only components that must be present in a composition according to the teaching of FOWLER and are also present in the claimed cleansing emulsion are a surfactant (mentioned among many others in FOWLER is sodium laureth sulfate) and water (the presence of which is implied in instant claim 1 by the term "emulsion").

In other words, the disclosure of FOWLER is (extremely) broad, as also pointed out by the Examiner (see page 7, second paragraph and page 8, line 1 of the instant Office Action). It is thus, not surprising that in the passage bridging pages 3 and 4 of the instant Office Action the Examiner has to arbitrarily pick, choose and combine selected passages from columns 2, 10, 13, 15 and 16 of FOWLER in an attempt to show that FOWLER (inherently) discloses an emulsion that exhibits several of the elements recited in instant claim 1. The Examiner even is forced to rely upon specific Examples of FOWLER in this regard, i.e., on the emollient cleansers of Examples 1 and 2 (which comprise 0.8 % of cetyl alcohol, which allegedly corresponds to component (c)(ii), or 0.20 of a polymer, which allegedly corresponds to component (b) of the instantly claimed emulsion). According to the Examiner these Examples are "the narrowest of the disclosures of the prior art" (page 7, second paragraph of the instant Office Action), obviously implying that they must not be relied upon by Applicants.

At any rate, the Examiner's reliance on Examples 1 and 2 of FOWLER is apparently without merit because the corresponding emollient cleansers could hardly be much more different from the claimed emulsion.

For example, the emollient cleanser of Example 1 of FOWLER contains no paraffin oil (instant component (c)(i)), contains no acrylate polymer (instant component (b)), and contains no

anionic surfactant (let alone sodium laureth sulfate and/or sodium myreth sulfate, instant component (a)). On the contrary, the cleanser of Example 1 contains a cationic compound (1.50 % of distearyl dimethyl ammonium chloride). Even further, the water content of the emollient cleanser of Example 1 is about 80 % by weight, i.e., far higher than the highest water content that is possible in the claimed emulsion (i.e., about 55 %).

Similarly, the emollient cleanser of Example 2 of FOWLER contains no paraffin oil (instant component (c)(i)), and contains no anionic surfactant (let alone sodium laureth sulfate and/or sodium myreth sulfate, instant component (a)). On the contrary, the cleanser of Example 2 contains a cationic compound (0.20 % of Polyquaternium 10). Even further, the water content of the emollient cleanser of Example 2 is about 86 % by weight, i.e., far (more than 30 %) higher than the highest water content that is possible in the claimed emulsion.

It further is pointed out again that FOWLER discloses hundreds of surfactants and types of surfactants, hundreds of (optional) emollients and types of emollients and many examples of optional thickeners that are suitable for use in the compositions disclosed therein, giving rise to millions of possible combinations of surfactants, emollients and thickeners and thus, compositions according to FOWLER.

In this regard, Applicants again refer to MPEP 2144.08 II, according to which the fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a *prima facie* case of obviousness, making reference to *In re Baird*, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994), *In re Jones*, 958 F.2d 347, 350, 21 USPQ2d 1941, 1943 (Fed. Cir. 1992), and *In re Deuel*, 51 F.3d 1552, 1559, 34 USPQ2d 1210, 1215 (Fed. Cir. 1995).

Applicants note that in this regard the Examiner dismisses the cited case law as allegedly applying exclusively to genus-species situations. However, there is no reason why a narrow subgenus of a broad genus should not be treated in the same way as a species. This is acknowledged in the MPEP by referring to “a claimed species or subgenus”.

Regarding the Supreme Court decision *KSR Int'l Co. v. Teleflex Inc.* relied upon by the Examiner at page 6 of the instant Office Action Applicants note that this decision also states that “[a] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” Emphasis added. Further, “[w]e must still be careful not to allow hindsight reconstruction of references to reach the claimed invention without any explanation as to how or why the references would be combined to produce the claimed invention.” *Innogenetics, N.V. v. Abbott Labs.*, 512, F.3d 1363, 1374 n.3 (Fed. Cir. 2008).

Regarding page 7, fourth paragraph of the instant Office Action, Applicants point out that the recitation of “from about 0.05% to about 40% of a surfactant selected from the group consisting of nonionic surfactants, anionic surfactants, cationic surfactants, amphoteric surfactants, zwitterionic surfactants, and mixtures thereof” in col. 2, lines 41-45 of FOWLER can clearly not reasonably be considered to be a teaching or a suggestion to use “from 2 % to about 17 % by weight of at least one of sodium laureth sulfate and sodium myreth sulfate” as recited in instant claim 1.

Applicants further point out that whether or not FOWLER teaches or suggests individual elements that are recited in the instant claims is irrelevant as long as the Examiner has failed to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.

Regarding the viscosity range of 500 to 60,000 mPa s disclosed in GORDON, it is pointed out again that this range is broad enough to encompass almost any conceivable viscosity of a liquid. In particular, the viscosity range recited in instant claim 1 accounts for only about 5 % of the entire viscosity range disclosed in GORDON.

In this regard, the Examiner's attention is directed to MPEP 2144.05 I. which states, *inter alia* (emphasis added):

"[A] prior art reference that discloses a range encompassing a somewhat narrower claimed range is sufficient to establish a *prima facie* case of obviousness." *In re Peterson*, 315 F.3d 1325, 1330, 65 USPQ2d 1379, 1382-83 (Fed. Cir. 2003). See also *In re Harris*, 409 F.3d 1339, 74 USPQ2d 1951 (Fed. Cir. 2005)(claimed alloy held obvious over prior art alloy that taught ranges of weight percentages overlapping, and in most instances completely encompassing, claimed ranges; furthermore, narrower ranges taught by reference overlapped all but one range in claimed invention). However, if the reference's disclosed range is so broad as to encompass a very large number of possible distinct compositions, this might present a situation analogous to the obviousness of a species when the prior art broadly discloses a genus. *Id.* See also *In re Baird*, 16 F.3d 380, 29 USPQ2d 1550 (Fed. Cir. 1994); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); MPEP § 2144.08.

It is submitted that for at least all of the foregoing reasons and the additional reasons set forth in the response to the previous Office Action, FOWLER in view of GORDON and MERCIER fails to render obvious the subject matter of any of the claims of record, wherefore

the instant rejection under 35 U.S.C. § 103(a) over these documents is without merit, warranting withdrawal thereof.

***Response to the Rejection over FOWLER, GORDON, MERCIER and McLAUGHLIN***

Dependent claims 17 and 33 remain rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over FOWLER in view of GORDON, MERCIER and McLAUGHLIN. The reasons for the rejection are presumably the same as those set forth in the previous Office Action.

This rejection is again respectfully traversed as well, for the reasons set forth in the response to the previous Office Action. The corresponding remarks are expressly incorporated herein.

***Response to the Rejection over FOWLER, GORDON and HA***

Claims 6 and 30 are newly rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over FOWLER in view of GORDON and HA. The rejection concedes that FOWLER and GORDON fail to teach that sodium myreth sulfate can be used as a surfactant but alleges that this deficiency is cured by HA.

This rejection is respectfully traversed as well. In this regard, it is noted that claims 6 and 30 are dependent claims. HA is unable to cure the deficiencies of FOWLER and GORDON set forth above, wherefore claims 6 and 30 are not rendered obvious over FOWLER in view of GORDON and HA for at least all of the reasons which are set forth above and in the response to

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the previous Office Action in connection with the rejection of the corresponding independent claims as allegedly being unpatentable over FOWLER in view of GORDON and MERCIER.

### CONCLUSION

In view of the foregoing, it still is believed that all of the claims in this application are in condition for allowance, wherefore an early issuance of the Notices of Allowance and Allowability is respectfully solicited. If any issues yet remain which can be resolved by a telephone conference, the Examiner is respectfully invited to contact the undersigned at the telephone number below.

Respectfully submitted,  
Michaela KOHUT et al.

/Heribert F. Muensterer/  
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Heribert F. Muensterer  
Reg. No. 50,417

May 30, 2011  
GREENBLUM & BERNSTEIN, P.L.C.  
1950 Roland Clarke Place  
Reston, VA 20191  
(703) 716-1191